

REMARKS

Favorable reconsideration of the subject application, as amended above, is respectfully requested in view of the comments below.

Claims 1-25 are pending in the subject application. Claims 14-25 have been withdrawn from consideration. Accordingly, claims 1-13 are presented for examination on the merits.

The specification has been amended to correct the wording of the claim for priority.

Applicant acknowledges finality of the restriction requirement.

I. **Objection to the Specification**

The specification is objected to for incorporating by reference allegedly essential material. This objection is respectfully traversed as follows.

The Examiner has not indicated how the incorporated material is essential to carrying out the claimed invention. However, it is noteworthy that the incorporated materials are set forth in an example which does not limit the myriad number of ways in which the invention can be carried out. For example, the incorporated materials refer to a strain of *Agrobacterium tumefaciens* that was used to generate protoplasts, but any strain of *Agrobacterium tumefaciens* may be used. The particular strain used in the example is not limiting, and is not essential to the claimed invention. The other incorporated references in paragraph 57 merely disclose the pCVE plasmid which was used to generate the vector for T-DNA tagging mutagenesis, but other plasmids may be used to the same end. T-DNA tagging is a well known methodology for activation mutagenesis, and the specification merely cites to the plasmid that was used in one example of the invention. The cited pCVE plasmid is not the only plasmid that can be used for

Serial No.: 10/045,677

In The Drawings:

New replacement sheets are enclosed and replace the drawings originally filed in the application.

activation mutagenesis to generate protoplasts and therefore, the cited references do not disclose material that is essential to carrying out the claimed invention.

Accordingly, the objection to the specification is respectfully traversed.

II. Double Patenting

The Examiner states that claims 10 and 11 substantial duplicates of one another and upon allowance of one, the other will be objected to under 37 C.F.R. § 1.175.

It is respectfully pointed out to the Examiner that claim 10 is directed to use of nicotinic acetylcholine **agonist**, while claim 11 is directed to use of an **antagonist**. Thus, these claims are not duplicates of one another, and indeed, are directed to use of compounds whose actions are significantly different from each other. Accordingly, objection to these claims is improper.

III. Rejection of Claims Under 35 U.S.C. § 112, Second Paragraph

Claim 3 is rejected under 35 U.S.C. § 112, second paragraph as allegedly being indefinite. The Examiner asserts that the meaning of the term “regulatory gene” is unclear.

Applicant respectfully disagrees.

Enclosed herewith are copies of relevant pages of Molecular Biology of the Gene, 3rd. edition, which provide an art accepted definition of “regulatory genes.” As can be seen, a regulatory gene functions to control the rate of synthesis of the products of other genes. One of skill in the art at the time of the invention would recognize the meaning of this term and therefore, understand the metes and bounds of the claimed invention. Accordingly, the rejection of claim 3 under 35 U.S.C. § 112, second paragraph is respectfully traversed.

IV. Rejection Under 35 U.S.C. § 102(b)

Claims 1-4 and 6-9 are rejected under 35 U.S.C. § 102(b) as being anticipated by Fritze *et al.* The Examiner asserts that the cited reference teaches each limitation of the claimed invention.

This rejection is respectfully traversed as follows.

The present invention is directed to a method for identifying plant genetic material whose actions cause increased production of a metabolite. In the present method, transformed calli are grown and sampled in a manner that retains their viability and provides cells for testing for the presence of the metabolite of interest and establishing a cell line and/or library. Thus, in the present invention, the presence or absence of a desired metabolite is established in the early stages of plant regeneration.

In contrast, the cited reference does not disclose sampling transformed calli such that the calli remain viable, nor does it disclose obtaining cells from the calli for further testing, and cell line development. Instead, the cited reference discloses that for genetic analysis, regenerated plants are selfed and/or cross-pollinated with wild-type pollen. The progeny are analyzed for segregation of the selective marker used in generation of the protoplasts. It is further disclosed that novel phenotypes are ideally detectable at the seedling level. Thus, Fritze *et al.*'s method requires regeneration of plants, crossing and analysis of seedlings, which are process steps eliminated by the present method.

Accordingly, the rejection of claims 1-4 and 6-9 under 35 U.S.C. § 102(b) is respectfully traversed.

V. Rejection of Claims Under 35 U.S.C. § 103(a)

Claim 5 is rejected under 35 U.S.C. § 103(a) as being unpatentably obvious over Fritze *et al.* in view of Browning *et al.* The Examiner relies on Fritze as above, and Browning *et al.* as teaching the use of radioligand displacement assay to detect opiates. The Examiner concludes, therefore, one of ordinary skill in the art would have had a reasonable expectation of success in applying the radioligand displacement assay to Fritze *et al.*'s method.

This rejection is respectfully traversed as follows.

As discussed above, the method taught by Fritze *et al.* requires propagation of plants, cross-breeding and seed testing. Thus, even if Fritze's method were modified by use of Browning *et al.*'s radioligand displacement assay, the result would not be the present invention, nor would it render the present invention obvious. Fritze *et al.* teaches a labor intensive method of propagating plants and cross-breeding or selfing for genetic analysis, while the present invention eliminates these steps. There is no teaching in Fritze *et al.* or in the secondary reference that suggests undertaking genetic analysis of calli without disrupting their growth and viability. As such, the present invention is not obvious over the cited combination of prior art.

Accordingly, the rejection of claim 5 under 35 U.S.C. § 103(a) over Fritze *et al.* and Browning *et al.* is respectfully traversed.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

MCDERMOTT WILL & EMERY LLP



Judith L. Toffenetti
Registration No. 39,048

600 13th Street, N.W.
Washington, DC 20005-3096
202.756.8000 JLT:ajb
Facsimile: 202.756.8087
Date: September 8, 2004

WDC99 970748-1.050229.0295

BEST AVAILABLE COPY

Molecular Biology of the Gene

3^{RD EDITION}

James D. Watson

HARVARD UNIVERSITY AND
COLD SPRING HARBOR LABORATORY

*With illustrations by
Keith Roberts*



W. A. BENJAMIN, INC.
Menlo Park, California
Reading, Massachusetts
London · Amsterdam
Don Mills, Ontario · Sydney

BEST AVAILABLE COPY

Various editions of this work appear in the following translations:

French
Inter European Editions
De Lairessestraat 90
Amsterdam 1007, The Netherlands

Polish
Panstwowe Wydawnictwo Naukowe
Miodowa 10
Warsaw 5, Poland

Hungarian
Medicina Publishers
c/o Artisjus
H-1364 Post Box 67
Budapest V. Hungary

Romanian
Editura Stiintifica
Sectorul 4, Bd. Republicii 17
Bucharest, Romania

Italian
Nicola Zanichelli
via Irnerio 34
Bologna, Italy

Serbo Croatian
Naučna Knjiga
c/o Jugoslovenska Autorska Agencija
Majke Jevrosime 38
Beograd, Yugoslavia

Japanese
Kagaku Dojin
Yanagino-Banba
Oike-Sagarie
Nakakyō-ku, Kyoto-shi
Japan

Spanish
Fondo Educativo Interamericano
3a. Avenida entre Transversales 7 y 8
Quinta "Carmencita", Altamira
Caracas, Venezuela

German
Inter European Editions
De Lairessestraat 90
Amsterdam 1007, The Netherlands

Turkish
Hacettepe University
Hacettepe, Ankara, Turkey

Cover photograph: Electron micrograph of SV40 specific chromatin circles isolated from monkey cells infected with SV40. [Kindly supplied by O. Croissant, C. Cremisi, P. Pignatti, and M. Yaniv, Institut Pasteur, Paris.]

Copyright © 1976, 1970, 1965, by W. A. Benjamin, Inc. Philippines copyright 1976, 1970, 1965, by W. A. Benjamin, Inc.

All rights reserved. No part of this publication may be reproduced, stored in a retrieval system, or transmitted, in any form or by any means, electronic, mechanical, photocopying, recording, or otherwise, without the prior written permission of the publisher. Printed in the United States of America. Published simultaneously in Canada. Library of Congress Catalog Card No. 75-14791.

ISBN 0-8053-9609-8
ABCDEFGHIJ-DO-798765

osition
phos-
jacention of
e and
peptideomes
ged in2000)
ation.
char-ch, in
1.

s and

, the
ion ofsystem
ed by

meri-

blue-
orange-
l bio-

d ini-

.de or
e cor-

.)

ymes,

A class of proteins rich in the basic amino acid arginine. They are found complexed to the DNA of the sperm of many invertebrates and fish.

The state of a virus in which it is integrated into a host cell chromosome and is thus transmitted from one cell generation to another.

Open loops, like those of lamprey chromosomes, found in polytene chromosomes. The larger and more diffuse their appearance, the higher the rate of transcription.

A radioactively labeled compound is added to living cells or a cell extract (pulse) and, a short time later (e.g., five seconds), an excess of unlabeled compound is added to dilute out the "hot" compound. Samples are then taken at periods after the pulse to follow the course of the label as the compound is metabolized (chase).

Antibiotic that inhibits polypeptide synthesis by competing with amino-acyl tRNA's for ribosomal binding site "A."

An isotope with an unstable nucleus that stabilizes itself by emitting ionizing radiation.

The incorrect placement of an amino acid residue in a polypeptide chain during protein synthesis.

An allele which exerts its phenotypic effect only when present in homozygous form, being otherwise masked by the dominant allele.

The appearance in the offspring of traits that were not found together in either of the parents.

Genes whose primary function is to control the rate of synthesis of the products of other genes.

Specific proteins involved in the reading of genetic stop signals for protein synthesis.

The return of a protein or nucleic acid from a denatured state to its "native" configuration.

Enzymatic excision and replacement of regions of damaged DNA. Repair of thymine dimers by UV irradiation is best understood example.

Y-shaped region of chromosome that is a growing point in DNA replication.

The structure of a nucleic acid at the time of its replication—the term most frequently used to refer to double-

Protamines

Provirus

Puffs

Pulse-Chase Experiment

Puromycin

Radioactive Isotope

Reading Mistake

Recessive

Recombination

Regulatory Genes

Release Factors

Renaturation

Repair Synthesis

Replicating Fork

Replicating Forms (RF)